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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,883	11/18/1999	JEROME BOMBAL	VL5-062	7906

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PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
INTELLECTUAL PROPERTY & STANDARDS
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SAN JOSE, CA 95131

EXAMINER

THOMSON, WILLIAM D

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 02/10/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

pre

Office Action Summary	Application No. 09/443,883	Applicant(s) BOMBAL ET AL.	
	Examiner William D. Thomson	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 remain pending and stand rejected.
2. Applicant's response is held non-responsive for the following reasons:
 - a. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited
 - b. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
 - c. Even though five separate references were clearly asserted with formal rejections under 35 U.S.C. 102 (e) and (b) this does not discharge the Applicant from their duty to respond and delineate any patentable novelty over the prior art asserted; the burden of proof had been shifted to the Applicants and they have not responded completely.
 - d. Complaining of the brevity of the rejection and the lack of specificity may only have some reasonable merit when the issues (the prior art for example) are of such a complex nature that one of ordinary skill level looking to the prior rejections could not reasonably and knowingly respond to the rejections. In the instant case the prior art teachings, individually, clearly and expressly recited within their individual teachings the claimed invention. The prior art is in the same industry and directed to

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solving the same problem with the same technology as Applicant is teaching and reciting in their specification and claims. To provide a complete response Applicant must provide where the prior art's individual teachings might diverge from the claimed invention.

3. MPEP explicitly states: "A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability" and "An application should not be allowed , unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it "strictly adhere" to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The standard to be applied in all cases is the "preponderance of the evidence" test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable " and "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is *complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable*. The pertinence of each

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reference, *if not apparent*, must be clearly explained and each rejected claim specified" Examiner does not believe this raises to the level of "complex" and that the individual teachings are apparent (performing diligence in reviewing these five patents in the same technology and solving the same problems it is clear their pertinence). Further the examiner only cited the most relevant prior art teachings at his command (five individual teachings from thousands of patents in the field of scan failures and timing analysis) and has designated them as nearly practicable (Applicant can identify which art is being asserted and their entire individual teachings are designated and asserted against each and every claim).

4. Anticipation is a question of fact. *In re King*, 801 F.2d 324, 231 USPQ 136 (Fed. Cir. 1986). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. Denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it. Where, as here, a reference describes the recited invention, the reference must be analyzed to determine whether it describes the invention with sufficient specificity to constitute an anticipation under the statute. See *In re Schaumann* 572 F.2d 312, 197 USPQ 5 (CCPA 1978), also *Ex parte Lee*, BPAI at 31 USPQ2d 1105) Applicants are further directed to that fact that express and inherent

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disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir.1995) Further see *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). As of yet the examiner has not asserted inherency, like for example labeling the graph related to the data obtained to render the information useful. This may become an issue once Applicant discharges there duty in identifying any possible patentable distinction over the prior art asserted in the formal rejections within the forthcoming response.

5. *Prima facie* means at first sight, on the first appearance, on the face of it, so far as can be judged from the first disclosure, presumably or a fact presumed to be true unless disproved by some evidence to the contrary. *Prima facie* case is made when such will prevail until contradicted and overcome by other evidence or which has proceeded upon sufficient proof to that stage where it will support finding if evidence to the contrary is disregarded. (*recited from: Black's Law Dictionary, 5th Edition*) A *prima facie* case can be made by the Examiners' assertion of the prior art associated with the pending claims that would render the claims unpatentable. As to the allowability or patentability of Applicants' claimed invention, only a "preponderance of the evidence" needs to be applied to make the determination of the allowability or patentability of pending claims. The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only

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that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it. See Black's Law Dictionary 1071 (5th Ed. 1979). See generally *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing cases showing the evolution of the concept in patent examination of prima facie obviousness as a legal inference drawn from uncontradicted evidence).(reciting from *In re Spada* (CA FC) 15 USPQ2d 1655 (8/10/1990))

6. In summary there is no requirement to map the claims as has been asserted by Applicant to meet the burden of making a prima facie case of anticipation. More importantly this does not discharge Applicant of their responsibility to rebut the Examiner's formal rejections and provide evidence to the contrary that might so that the prior art asserted does not teach specific limitations of the claimed invention. Examiner without any relevant evidence to the contrary has determined that the Applicant's claims pending in the instant case are not allowable over the prior art made of record. Applicants are charged with the duty to rebut and provide evidence in the contrary of the Examiner's assertion of the prior art's teaching the claimed invention, yet have not availed themselves to provide such. Since no such challenge has been presented the rejection stands and the response held non-responsive.

CONCLUSION

7. The reply filed on August 11, 2003 was not fully responsive to the prior Office Action because of the aforementioned omission(s) or matter(s). See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Thomson whose telephone number is (703) 305-0022. The examiner can be usually reached between 9:30 a.m. - 4:00 p.m. Monday thru Friday. Voice mail is checked throughout the day. Please leave a detailed message including the serial number.
9. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Kevin Teska, can be reached on 704-305-9704.
10. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-305-3900.



William D. Thomson
Primary Examiner
A.U. 2123
February 5, 2004